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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91265309
Party	Defendant Zox LLC
Correspondence Address	DANIEL M CISLO CISLO & THOMAS LLP 12100 WILSHIRE BLVD SUITE 1700 LOS ANGELES, CA 90025-7103 UNITED STATES Primary Email: ttab@cislo.com Secondary Email(s): stephanie@cislo.com, dan@cislo.com, kbond@cislo.com, david@cislo.com 310-979-9190
Submission	Motion to Suspend for Civil Action
Filer's Name	Katherine M. Bond
Filer's email	kbond@cislo.com, ttab@cislo.com
Signature	/Katherine M. Bond/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE TRADEMARK
TRIAL AND APPEAL BOARD**

House of Kuipers, LLC <i>et al.</i> , Opposer, v. John Zox Applicant.	Trademark: ZOX (Standard Character Word Mark) Application Serial No.: 88/228,839 Opposition No.: 91252817
John Zox, Opposer, v. Zox LLC. Applicant.	Trademark: ZOXLIST (Standard Character Word Mark) Application No.: 88/582,432 Opposition No.: 91265309
John Zox, Opposer, v. Zox LLC. Applicant.	Trademark:  Application No.: 88/829,957 Opposition No.: 91265525

**MOTION TO SUSPEND PROCEEDINGS PENDING OUTCOME OF
CIVIL LITIGATION**

House of Kuipers LLC and Zox LLC (the “Zox Company”) hereby move to suspend to the above-referenced opposition proceedings pursuant to Trademark Rule 2.117(a), 37 C.F.R § 2.117(a). On February 22, 2021, Zox LLC, filed a Complaint with the United States District Court, in the Central District of California (Case No. 2:21-cv-01609-PA-SK) against John Zox, Daniel Zox and Andrew Zox,

asserting claims of trademark infringement and unfair competition among other claims (the “Action”). Some of the relief sought in the complaint is cancellation of Registration No. 5,268,843 (subject of Cancellation Proceeding No. 92074323), and express abandonment of Application Serial No. 88/228,839. Please note, that counsel in Cancellation Proceeding No. 92074323 has already consented to suspension. A copy of the federal court complaint is attached without the exhibits due to size limitations.

The Board's general practice is to suspend *inter partes* proceedings under Trademark Rule 2.117(a) whenever the Board is made aware that any party to a pending Board Proceeding is involved in a civil action which may have a bearing on the Board case. To the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court's findings are binding on the Board, whereas the Board's findings are merely advisory to the district court. See *id.*; TBMP Section 510.02(a) (2014); see also *General Motors Corp. v. Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992); see also *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 U.S.P.Q.2D (BNA) 1550, 1552 (TTAB 2011) (noting “the civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board”); *The Other Telephone Co. v. Connecticut Nat’l Telephone Co.*, 181 U.S.P.Q. 125 (TTAB 1974) (noting that once a civil action between the parties is filed in federal court, “[t]he only question for determination ... is whether the outcome of the civil action will have a bearing on the issues involved in the opposition proceeding.”). In this case, the Action references all of the TTAB proceedings involves the same set of facts and the exact same parties involved in the TTAB proceedings and will therefore have a direct bearing on this proceeding.

The central issue of the complaint is the determination of rights among the parties and the priority of rights. In the Cancellation Proceeding and all of the above-referenced opposition proceedings the same issues are being addressed. John Zox has asserted the 5,268,843 Registration and the same alleged common law rights in an attempt to oppose or cancel *all* of the Zox Company’s registrations and applications. Regardless of whether John Zox is appearing individually or with his brothers, the same trademark rights being asserted against the Zox Company. What remains to be decided is, does the Zox

band have any trademark rights in and to the mark ZOX? If so, in connection with what goods and services? Do the Zox Brothers have trademark rights to the word ZOX, and if so for what? What are the Zox Company's rights in the ZOX mark? Thus, the issues of priority and likelihood of confusion will ultimately be resolved in the Action, and that court's decision will likely be binding upon the Board. See TBMP § 510.02(a); *Whopper Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. (BNA) 805 (TTAB 1971) (granting a motion to suspend when movant had filed an action in federal district court that would "have a direct bearing on the question of the rights of the parties herein and may in fact completely resolve all the issues," noting that "a decision by the United States District Court would be binding on the Patent Office."). Accordingly, allowing the Federal District Court to decide the issues first is efficient and permits the Board to avoid wasted time in deciding issues that will ultimately be decided by the court.

Therefore, the Zox Company respectfully requests suspension of these Proceedings pending determination of the civil action pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a) pending the outcome of the Action.

Respectfully submitted,
CISLO & THOMAS LLP

Dated: March 17, 2021

/Katherine M. Bond/

Daniel M. Cislo, Esq.
Katherine M. Bond, Esq.
David B. Sandelands, Esq.
CISLO & THOMAS LLP
12100 Wilshire Blvd., Suite 1700
Los Angeles, CA 90025
Tel: (310) 451-0647
Fax: (310) 394-4477

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing: **MOTION TO SUSPEND PENDING CIVIL LITIGATION** has been served on John Zox' counsel via email:

Counsel for Applicant:
DARREN GELIEBTER
ERIC HUANG
deliebter@lgtrademarklaw.com
ehuang@lgtrademarklaw.com

Dated: March 17, 2021

/Katherine M. Bond/
Katherine M. Bond, Esq.

DANIEL M. CISLO (SBN 125378)
dan@cislo.com
DAVID B. SANDELANDS (SBN 198252)
dsandelands@cislo.com
KATHERINE M. BOND (SBN 263020)
kbond@cislo.com
CISLO & THOMAS LLP
12100 Wilshire Blvd., Ste. 1700
Los Angeles, CA 90025
Telephone: (310) 979-9190

Attorneys for Plaintiff
ZOX LLC

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

ZOX LLC, a California limited liability
company,

Plaintiff,

v.

JOHN ZOX, an individual, DANIEL
ZOX, an individual, and ANDREW
ZOX, an individual, and DOES 1-10,
inclusive,
Defendants.

Case No. 2:21-cv-01609

COMPLAINT

**1. TRADEMARK
INFRINGEMENT;
2. FALSE DESIGNATION OF
ORIGIN;
3. COMMON LAW TRADEMARK
INFRINGEMENT;
4. STATUTORY UNFAIR
COMPETITION; AND
5. COMMON LAW UNFAIR
COMPETITION.**

REQUEST FOR JURY TRIAL

Plaintiff ZOX LLC, by its attorneys, Ciso & Thomas LLP, alleges as
follows:

INTRODUCTION

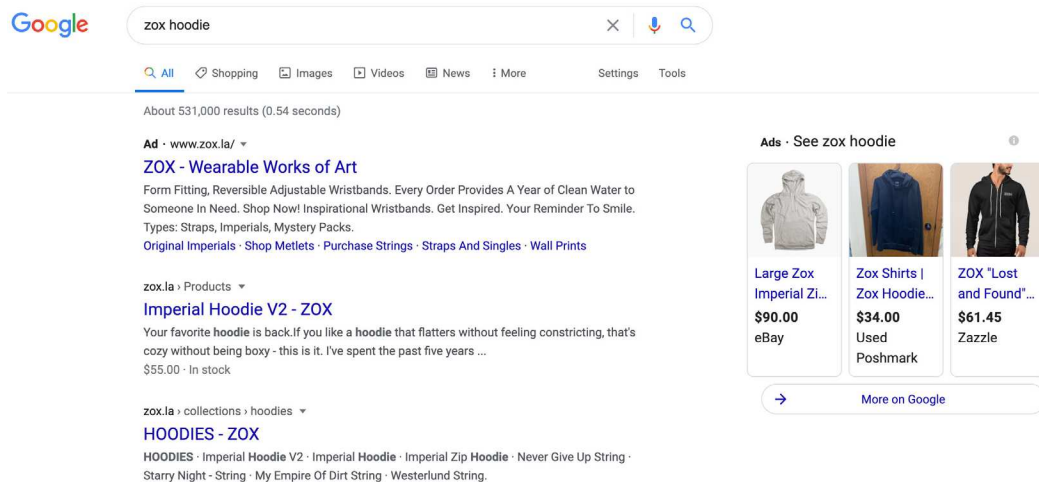
1
2 1. At least as early as, September of 2011, Zox LLC, its predecessors-in-
3 interest, and its related entities (the “Zox Company” or “Plaintiff”), began using
4 the mark “ZOX” on its popular fashion accessory line of bracelets or straps. The
5 ZOX mark is the subject several U.S. Registrations including, but not limited to,
6 Registration No. 4,465,691, for use in connection with wristbands and shirts as
7 well as bracelets (the “691 Registration”). The ‘691 registration issued on January
8 14, 2014. Since its launch over ten years ago, the company has become very
9 successful offering a wide variety of retail goods in the United States and
10 internationally.

11 2. The Defendants last name is “Zox”. John Zox was in a band called
12 “Zox” in the early 2000’s while Daniel and Andrew Zox appear to be involved in
13 photography and film production. Collectively John, Daniel and Andrew Zox are
14 referred to as “Defendants” or the “Zox Brothers”. Plaintiff had never had any
15 interaction with the Defendants prior to 2016.

16 3. On information and belief, at some point in time, the Zox Brothers
17 learned of the Zox Company and its success and began a campaign of deceit to
18 interfere with the Zox Company’s trademarks and business. Starting in 2016, the
19 Zox Brothers filed trademark applications alleging Defendants were selling goods
20 that were closely related, or identical to Plaintiff’s products.

21 4. Upon further investigation, Defendants had not previously and were
22 not presently selling the applied-for goods as alleged in the trademark applications.
23 The Defendants are providing false information to make it appear as though they
24 have been selling these goods all along when in fact they were not and are not-
25 committing multiple acts of fraud on the Trademark Office and manipulating
26 electronic information in an attempt to improve their legal position at the
27 Trademark Trial and Appeal Board (“TTAB”).
28

5. The infringement of the Zox Company's trademarks rights has become increasingly aggressive and intolerable when Defendants recently launched products using a similar logo that directly compete with the Zox Company's goods that are being sold in the same channels of commerce as shown in the screenshot below.



6. The Zox Company is seeking this Court's assistance to enjoin Defendants from using, selling or offering to sell consumer goods or retail products under the ZOX mark and to award monetary relief for Defendants' past violations.

PARTIES

7. Plaintiff Zox LLC, is a California limited liability company and has its principal place of business located at 5304 Derry Ave Suite G, Agoura Hills, CA 91301 within the City and County of Los Angeles in the State of California.

8. Defendant John Zox is an individual who on information and belief resides at 81 Thorndale Road, Slingerlands, New York, 12159-9753.

9. Defendant Daniel Zox, is an individual who on information and belief resides in Los Angeles having an address of 639 Navy St., Apt. C, Santa Monica, California, 90405-5680.

10. Defendant Andrew Zox is an individual who on information and belief resides in Los Angeles at 6435 Bryn Mawr Drive, Los Angeles, California, 90068-2810.

1 11. On information and belief, the Defendants sued here in as Does 1-10
2 are individuals and entities whose names and identities are currently unknown to
3 Plaintiff and who are engaged in the acts described below. Plaintiff will amend its
4 complaint to identify these individuals or entities as soon as their identities become
5 known.

6 12. Plaintiff is informed and believes and, based thereon it alleges, that at
7 all times relevant to this complaint, there existed a relationship between each of the
8 Defendants in the nature of a joint venture, partnership, principal and agent,
9 employer and employee, master and servant, aider and abettor, and principal and/or
10 conspirator. Each and every act of each of the Defendants was duly authorized or
11 ratified by each of the other Defendants and carried out within the course and
12 scope of such relationship. Hereafter, Defendants John Zox, Andrew Zox, and
13 Daniel Zox (the “Zox Brothers”), and Does 1-10 shall be referred to collectively as
14 “Defendants”.

15 13. Plaintiff is informed and believes, and on that basis alleges, that each
16 of the Defendants participated in and is in some manner responsible for the acts
17 described in this Complaint and any damages resulting therefrom.

18 14. Plaintiff is informed and believes, and on that basis alleges, that each
19 of the Defendants have acted in concert and participation with each other
20 concerning the claims in this Complaint.

21 15. Plaintiff is informed and believes, and on that basis alleges, that each
22 of the Defendants was empowered to act as the agent, servant and/or employees of
23 each other, and that all the acts alleged to have been done by each of them were
24 authorized, approved and/or ratified by each of them.

25 **JURISDICTION AND VENUE**

26 16. The court has original jurisdiction of this action under 28 U.S.C. §§
27 1331, 1338(a) and 1338(b), and 2201 in that this case arises under the Trademark
28 Laws of the United States. This court has supplemental jurisdiction over Plaintiff’s

1 non-federal claims under 28 U.S.C. § 1367 in that those claims are so related to
2 Plaintiff's federal claims that they form part of the same case or controversy.

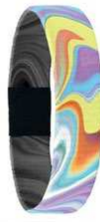
3 17. Venue in this district is proper under 28 U.S.C. § 1391(b) in that a
4 substantial part of the events giving rise to the within claims occurred in this
5 judicial district, some of the Defendants reside in this district, and Defendants'
6 conduct business including the sale of infirming products in this district.

7 **GENERAL ALLEGATIONS**

8 **The Zox Company and its "ZOX" Trademarks.**

9 18. The Zox Company is a family-owned business founded in in 2011, by
10 three brothers, with the help of their mom and a sewing machine. The company
11 presently headquartered in the Los Angeles area, started manufacturing and selling
12 bracelets or straps to wear as a fashion accessory. Through dedication and
13 countless hours of hard work, the business prospered over the last decade creating
14 an extremely successful company that is engaged in, among other things, the
15 production, sale and international distribution of consumer goods or retail
16 products.

17 19. The company offers a variety of bracelets today which are generally
18 accompanied by a "feel good" or inspirational message which created a faithful
19 following of fans where people collect and trade "Zox" bracelets worldwide. For
20 every bracelet that is sold, the Zox company makes a donation to the Thirst
21 Project, a foundation which provides clean water to those in need. In addition to
22 the bracelets, the Zox Company offers goods such as, keychains, clothing, and
23 bags. Examples of some of Zox' bracelets are shown below.



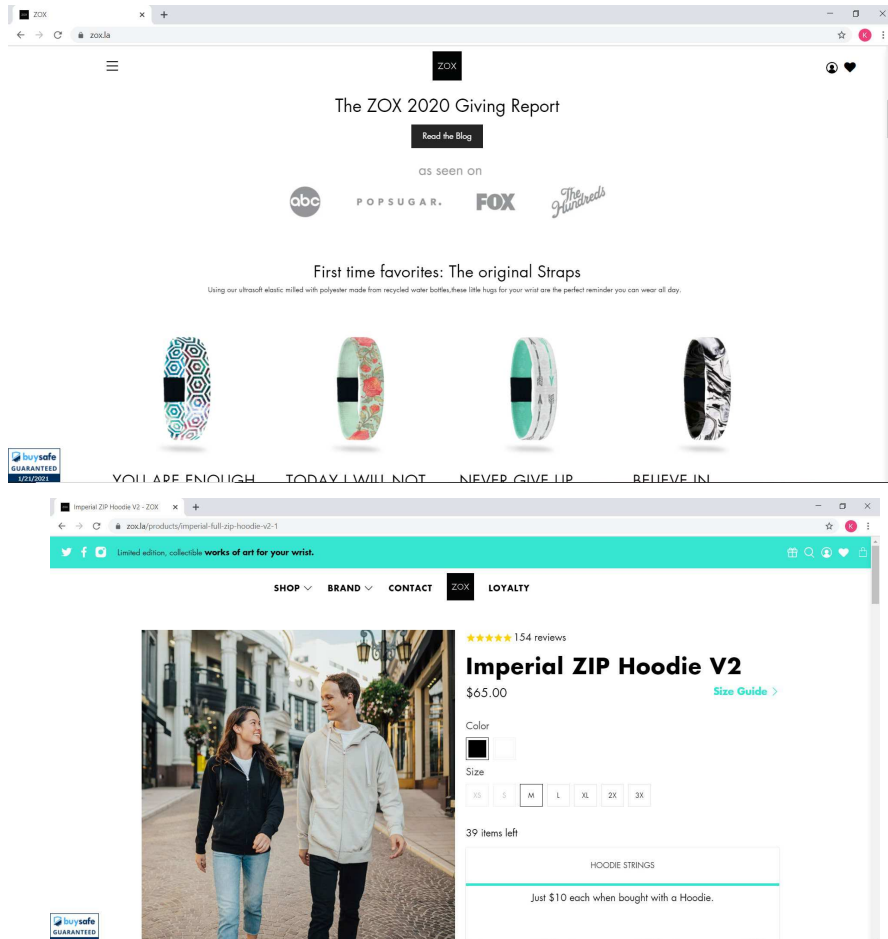
20. The Zox Company is the owner of several well-known trademarks including U.S. Trademark Registration No. 4,412,948 for the mark ZOX STRAPS for use in connection with elastic fabric wristbands in the nature of a bracelet which issued on October 8, 2013 with a first use in commerce date at least as early as September 15, 2011.

21. In the U.S., Plaintiff also owns the “ZOX” registrations listed in the table below. A true and correct copy of the Zox Company trademark registrations is attached hereto as Exhibit “1”.

Mark	Registration No.	Goods/ Services	First Use in Commerce Date
ZOX	4465691	Class 14: Wristbands in the nature of a bracelet. Class 25: Wristbands; shirts	Class 14: 09/15/2011 Class 25: 09/15/2011
ZOXBOX	4759961	Class 25: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Wristbands.	May 30, 2012
ZOX	5233845	Class 18: Backpacks. Class 35: On-line retail and wholesale store services featuring clothing apparel, wristbands, bags and accesso	Class 18: 10/31/2016 Class 35: 08/00 2011

22. The Zox Company’s trademarks comprising “ZOX” are hereinafter referred to as the “Zox Company Mark” or the “ZOX Mark”. In addition to its U.S. applications and registrations, Plaintiff owns numerous international registrations in order to protect its brand.

23. “ZOX” is a strong mark. For over ten years, the Zox Company has extensively used ZOX in various advertising and marketing campaigns, spending million dollars annually promoting the brand. Below are screenshots of the company’s website located at the domain <https://zox.la/>.



24. In April of 2013, Plaintiff acquired via assignment U.S. Registration No. 2992108 and all of the rights and goodwill associated with a design mark for ZOX for use in connection with clothing which issued on September 6, 2005 with a first use in commerce date of October 1, 1992.

25. Plaintiff's registrations are valid, subsisting and in full force and effect evidencing the validity of the Zox Company Mark and Plaintiff's exclusive right to use the mark in connection with the goods and services identified in the registrations.

26. The presence of the Zox Company Mark on Plaintiff's goods indicates to the public that goods and services provided under the Zox Company Mark originate with, or are provided by, the Zox Company. Plaintiff adheres to strict

1 quality standards in the manufacture of its products. Thus, the consuming public
2 has come to associate the Zox Company Mark with bracelets, clothing and other
3 goods and services of high quality.

4 27. As a consequence of all of the foregoing, the Zox Company Mark has
5 attained considerable value and the goodwill associated with it represents a
6 valuable business asset.

7 28. As a result of Plaintiff's long-term and widespread use of the highly-
8 distinctive Zox Company Mark in the United States via Internet, product
9 packaging, print advertising, and continuous and unsolicited media coverage, the
10 Zox Company Mark enjoys a high degree of consumer recognition.

11 **Defendants' Infringing Activities**

12 29. Defendant John Zox was part of a music band called the "Zox" Band
13 in the late 1990's to early 2000's. When the band was together and performing it
14 allegedly sold band merchandise in the form of t-shirts and stickers that comprised
15 of ornamental uses of "Zox". Ornamental use is not trademark use and not entitled
16 to trademark registration.

17 30. According to several Internet articles the band broke up in 2009, got
18 back together briefly in 2011 and played a reunion show in 2014 for \$15 a person
19 at a quaint small venue (less than 2K person capacity) called Lupo's in Rhode
20 Island, where the band was formed. Attached as Exhibit "2" are articles about the
21 music band.

22 31. According to their websites, John Zox' brothers Defendant Andrew
23 Zox and Defendant Daniel Zox produce short films. See <https://andrewzox.com/>
24 and <https://www.danielzox.com/>.

25 32. At some time, Defendants became aware of Plaintiff the Zox
26 Company and its success.

27 33. The Trademark Office records indicate that on March 28, 2016, the
28 Zox Brothers filed U.S. Application Serial No. 86954997 (the '997 Application)

1 for the standard character word mark “ZOX” for use in connection with goods in
2 classes 9, 25 and 41. Of particular importance is the class 25 goods and the
3 specimens filed for this class which claimed a first use in commerce date of
4 February 6, 2009, the specimens consisting of images of products that could be
5 purchased through Zazzle®. Attached as Exhibit “3” is a true and correct copy of
6 the ’997 Application.

7 34. Zazzle, headquartered in Redwood City, California is an online print
8 store where custom products can be made and offered to consumers. On
9 information and belief, the Class 25 goods were not being sold in commerce but
10 were included in the ’997 Application to make it appear as though the Zox
11 Brothers and the music band Zox were presently selling and had previously been
12 selling merchandise in the form of clothing and other retail items under the
13 trademark “ZOX”. Class 25 was refused registration in light of a registration
14 owned by the Zox Company.

15 35. On or about September 2, 2016, Mr. John Zox contacted Jason
16 Kuipers, a principal of the Zox Company demanding a consent to register. Mr.
17 Kuipers declined. The ’997 Application eventually matured into Registration No.
18 5,268,843 (the ’843 Registration) without the Class 25 goods.

19 36. On December 13, 2018, Mr. John Zox filed a new application, serial
20 no. 88228839 (the ’839 Application) for the standard character word mark “ZOX”
21 for use in connection with numerous goods and services that are similar to or
22 closely related to the Zox Company’s Marks including clothing, bracelets and
23 accessories. Of note again, is the first use in commerce date for each class of
24 goods which ranges between 2004 to 2007 and the specimens Mr. Zox submitted
25 to the Trademark Office, specifically images of goods that could be purchased
26 through the online custom print store Zazzle. Attached as Exhibit “4” is a true and
27 correct copy of the ’839 Application.

28

37. The specimens submitted appeared to be fake- images of goods that could be made via online print stores. They were similar, if not identical, to the specimens submitted for the Class 25 goods in the '997 Application including, the Zazzle specimens.

38. Plaintiff did not believe Defendant John Zox or the Zox Brothers had ever sold most if not all of the goods displayed in the specimens. Attached as Exhibit "5" is an example of how easy it is to create the submitted specimens.

39. In order to protect its business, the Zox Company was left with no choice but to oppose the '839 Application. Filing this opposition resulted in numerous filings at the TTAB as shown below. In every proceeding the '843 Registration has been used against the Zox Company.

MATTER	MARK	Ref. to '843 Reg.
Opposition No. 91252817 And Counterclaim	Opposition: ZOX App. No. 88/228,839	See Answer and Counterclaim, Pages 10-11, ¶6 and Exhibit A.
	Pet. To Cancel: Registration No. 4,465,691: ZOX; Registration No. 4,759,961: ZOXBOX; and Registration No. 5,233,845: ZOX	"Applicant—either individually, as co-applicant with his brothers Andrew Zox and Daniel Zox, or in partnership with fellow ZOX band member Eli Miller under the partnership name Zox Music—owns in whole or in part the right, title and interest in and to the ZOX Marks, 10 the applications and registrations for which are indicated below:..." See Table, page 11.
Pet. To Cancel No. 92074323	Pet. To Cancel Registration No. 5,268,843	John Zox Daniel Zox Andrew Zox
Opposition No. 91265309	Opposition ZOXLIST Application No. 88/582,432	See Notice of Opposition, Pages 3-4, ¶6 and Exhibit A.
	Pet. To Cancel Registration No. 5,268,843	"Opposer—either individually, as co-applicant with his brothers Andrew Zox and Daniel Zox, or in partnership with fellow ZOX band member Eli Miller under the partnership name Zox Music—owns in whole or in part the right, title and interest in and to the ZOX Marks,

		the applications and registrations for which are indicated below:...
		See Table, page 4
Opposition No. 91265525	Opposition ZOX (Design) Application No. 88/829,957	See Notice of Opposition, Pages 3-4, ¶5 and Exhibit A
		“Opposer—either as an individual, as co-applicant, or in partnership with fellow ZOX bandmembers—also owns in whole or in part the right, title and interest in the mark ZOX for a variety of goods and services, the applications and registrations for which are indicated below (collectively, Opposer’s “ZOX Marks”):...”
		See Table, page 4

40. On or about, July 21, 2020, the Zox Company served its First Set of Requests for Production and Interrogatories for Opposition No. 91252817.

41. In discovery, Defendant John Zox claims he owns rights in and to the “ZOX marks” either individually, as co-applicant with his brothers Andrew Zox and Daniel Zox and/or with fellow Zox bandmembers Eli Miller (Opposition Nos. 91265525 and 91252817).

42. Defendant John Zox further claimed in Opposition No. 91265309 that he owns the rights in a “partnership” called “Zox Music”. Mr. Zox also contends in his discovery responses that he is a member of the band and operates or is affiliated with several businesses namely, “...ZOX or ZOX MUSIC, [which] is managed by [John Zox’s] company ZOXRWERX LLC, is booked by [John Zox’s] company ZOX EVENTS, and is distributed by [John Zox’s] label ARMO RECORDS.

43. For document production, 192 documents were produced most of which were publicly available documents and none of which demonstrated sales to consumers for the applied-for goods in either the ’997 or the ’839 Applications.

1 Nor were any documents produced demonstrating a single sale of a good through
2 Zazzle.

3 44. In order to determine whether or not any “ZOX” goods had been sold
4 through Zazzle as represented to the Trademark Office, on January 5, 2021,
5 Plaintiff issued a subpoena to Zazzle. In response Zazzle produced the attached
6 spreadsheet. The spreadsheet shows the sales of goods through Zazzle. A true and
7 correct copy of the Zazzle subpoena without Exhibit 1 and Zazzle’s response is
8 attached as Exhibit “6”.

9 45. A review of the spreadsheet shows no goods were sold through Zazzle
10 as of the ‘997 Application filing date of March 28, 2016. And for the ‘839
11 Application with a filing date of December 13, 2018, it appears one of each good
12 was sold through Zazzle on December 31, 2020 - more than two years after the
13 ‘839 Application was filed and more than 4 years after the ‘997 Application and
14 long after the TTAB proceedings had been initiated.

15 46. In addition to not having sold any of the Class 25 goods as
16 represented to the Trademark Office at the time the applications were filed, the
17 Zox Brothers have not produced any evidence to show sales of numerous class 09
18 goods from the ‘997 Application including, but not limited to, “...prerecorded
19 video cassette tapes, audio and video discs in the nature of CDs and DVDs; film
20 and video equipment, namely still, motion picture film and video cameras,
21 videocassette recorders, videocassette players, digital video or audio players, and
22 film and video editing machines; computer software for film and video editing;
23 eyeglasses.”

24 47. For Class 41, Defendant John Zox has admitted there has not been any
25 “live” music events since 2014 which is two years before the ‘997 Application was
26 filed.

27 48. The Trademark Manual of Examining Procedures (TMEP) requires
28 goods **lawfully** be sold in interstate commerce to qualify for Federal registration

1 [emphasis added]. See TMEP Section 907 and 37 C.F.R. §2.69.

2 49. The ‘997 Application and ‘839 Application are *void ab initio*,
3 pursuant to 15 U.S.C. § 1051(a).

4 50. The Trademark Modernization Act “TMA” was signed into law on
5 December 27, 2020. The TMA provides expungement or reexamination options to
6 remove a registration on the basis that the trademark was never used in commerce
7 or was not in use in commerce as of the relevant date.

8 51. The ‘843 Registration is a candidate for expungement and/or
9 reexamination as the goods were never sold in commerce and most, if not all of the
10 services were not being provided at the time of the application filing date or during
11 the use in commerce dates provided to the Trademark Office.

12 52. On information and belief, in addition to not lawfully using the mark
13 in commerce as represented to the Trademark Office and committing fraud,
14 Defendants have modified and manipulated information online to in an attempt to
15 improve their legal position at the TTAB with regard to “use” of the mark ZOX.

16 53. For example, Mr. Zox provided the screenshot labeled “Figure A” as
17 shown in Exhibit “7” in Opposition Proceeding (No. 91265525, Notice of Opp.,
18 ¶10) titled, “*Fig. 2- The Zox Band website 2008-2020*”. Paragraph 10 of the Notice
19 states, “ZOX markets, promotes, and sells its merchandise online at its website
20 www.zoxband.com and www.zazzle.com, at shows/concerts, and via hundreds of
21 online streaming music platforms. All feature the ZOX (Stylized) Mark and related
22 ZOX Marks as shown by example of ZOX Band’s website in Fig. 2.”

23 54. As shown in Figure B of Exhibit 7, a review of the domain
24 zoxband.com via the Wayback Machine the archive page for November 16, 2017
25 does not display a post dated October 8, 2017 stating, “For news, updates,
26 community chatter, and more, head to the Official ZOX Facebook Page
27 <https://www.facebook.com/ZOX-6813512423/>”. This means even on November
28 16, 2017 there was no Oct. 8th 2017 post.

1 55. Further according to the Wayback Machine as shown in Figure C of
2 Exhibit 7, an archived page for December 18, 2020, does not display a post dated
3 January 1, 2020 “New year’s resolution: Add ZOX to my fave playlist! This
4 means in December of 2020 there were no posts from January 2020.

5 56. As demonstrated in the screenshots, the Zox Band website was
6 modified to make it appear some activity had occurred in the past several years.

7 57. In addition to the band’s website being edited, the Wikipedia page
8 referring to the music band Zox has also experienced a flurry of edits. In all of
9 2018 there were only three (3) edits. In 2020, there were over fifty (50) edits. For
10 example, on October 3, 2020 the statement “Zox *was* a band from Providence
11 Rhode Island” to “Zox *is* a band from Providence, Rhode Island. Additionally,
12 there was also an edit in 2020, that changed “years active” from “2002-2009” to
13 “2002-2009, 2010-Present” Attached as Exhibit “8” is the revision history for the
14 Wikipedia page.

15 58. On further information and belief, both Andrew Zox and Daniel Zox,
16 prior to this dispute used their full names in connection with the creation of their
17 art. After the dispute uses of terms such as “ZOX PROJECTS” started appearing
18 to make it seem there is tradename use as opposed to the surnames.

19 59. The Zox Company does not want to have any affiliation or association
20 with John Zox, the music band Zox, or the Zox Brothers nor does it want
21 consumers to be confused when they purchase a Zox Company product thinking it
22 is related to Mr. Zox, the music band Zox or the Zox Brothers.

23 60. The Zox Company does not “need” to trade on the goodwill of John
24 Zox, the music band Zox or the Zox Brothers, assuming any goodwill exists.

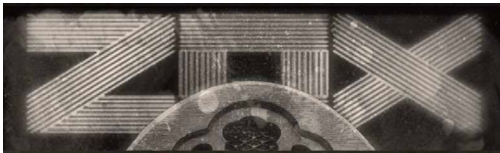
25 61. According to numerous streaming services and social media platforms
26 the band Zox no longer has a substantial fan following assuming arguendo it ever
27 did. Attached as Exhibit “9” are images of the parties’ social media pages and
28 streaming platforms.

62. The Instagram account for the music band Zox has approximately three hundred and four (304) followers as compared to the Zox Company that has approximately two-hundred and two thousand (202,000) followers. On Facebook the band Zox has approximately four thousand 4,000 followers and the Zox Company has over three hundred thousand (300,000) followers.

63. The music band Zox has less than ten thousand (10,000) monthly listeners on Pandora, ten thousand (10,000) listeners on Songkick and about sixteen thousand (16,000) on Spotify, these numbers represent global numbers.

64. On information and belief, in the last month Defendants have launched “new” clothing products identical to those of Plaintiff with a logo confusingly similar to the Zox Company logo as shown below.

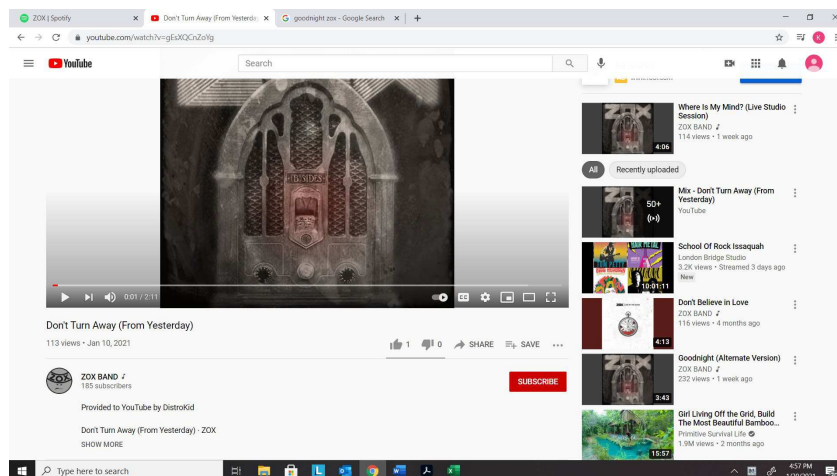
Defendant’s New Logo



Plaintiff’s Logo



65. On information and belief, to continue appearances, the Zox band “released” a new album on January 21, 2021. The new album consists of 9 songs, all of which are old songs remastered or rerecorded. On further information and belief the music was released on YouTube with 113 views.



1 66. For clarity, Plaintiff has never objected to Messieurs Daniel and
 2 Andrew Zox using their names in connection with their art, nor does Plaintiff
 3 object to old band merchandise bearing ornamental uses of “ZOX” that was
 4 previously sold when the band was active. The “new” products that Defendants
 5 have fabricated or attempted to fabricate in the past few years and as recently as
 6 last month are an infringement of Plaintiff’s rights.

7 67. Rather than ceasing infringement, Defendants are continuing their
 8 infringing activities oppressively, fraudulently, willfully and maliciously, with a
 9 conscious disregard of the Zox Company’s trademark rights and with a desire to
 10 injure Plaintiff’s business and to improve their own.

11 68. The Zox Company is left with no other options but to file this
 12 complaint for trademark infringement and unfair competition, among other claims.
 13 Defendants’ actions complained of herein were committed fraudulently,
 14 oppressively and maliciously.

15 **FIRST CLAIM FOR RELIEF**

16 (Against All Defendants for Trademark Infringement,

17 15 U.S.C. § 1114(1))

18 69. Zox Company incorporates, repeats and realleges paragraphs 1 - 68
 19 above, as if set forth fully herein.

20 70. The Zox Company Mark is owned by Zox Company and Zox
 21 Company has continuously used that mark in commerce since at least as early as
 22 September, 2011. The Zox Company has never authorized nor consented to the
 23 Defendants’ use of any term which is the same as, is confusingly similar to, or
 24 constitutes a colorable imitation of, the Zox Mark in commerce in connection with
 25 their products or services.

26 71. Defendants’ actions, as alleged above, are likely to cause confusion,
 27 mistake or deception in violation of Section 32(1) of the Lanham Act, 15 U.S.C. §
 28 1114(1).

72. Zox Company is informed and it believes and, based thereon it alleges that Defendants' acts have been undertaken with full knowledge of Zox Company rights in and to the ZOX Mark and with the willful and deliberate intent to cause confusion, mistake and deception among members of the relevant public and to trade on the goodwill associated with the ZOX Mark.

73. By reason of Defendants' acts, as alleged herein, Zox Company has suffered damage to its business, reputation and goodwill and Defendants have made profits and sales they would not have made but for Defendants' conduct.

74. Defendants' acts have caused and will continue to cause irreparable and immediate injury to Zox Company for which Zox Company has no adequate remedy at law. Unless Defendants are restrained by this Court from continuing their unauthorized use of words and symbols that are confusingly similar to the ZOX Mark, these injuries will continue to occur.

SECOND CLAIM FOR RELIEF

(Against All Defendants for False Designation of Origin,

15 U.S.C. § 1125(a))

75. Zox Company incorporates, repeats and realleges paragraphs 1- 68, and 70-74 above, as if set forth fully herein.

76. The ZOX Mark is owned by Zox Company and Zox Company has continuously used it in commerce for many years. Zox Company has never authorized or consented to the Defendants' use of the ZOX Mark or of any similar words or names in connection with their products or services.

77. Defendants' actions, as alleged above, are likely to cause confusion, mistake or deception as to the affiliation, connection or association of the Defendants with Zox Company, or as to the origin, sponsorship or approval of Defendants' products or services by Zox Company in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

1 78. Zox Company is informed and it believes and, based thereon it alleges
2 that Defendants' acts have been undertaken with full knowledge of Zox Company
3 rights in and to the ZOX Mark and with the willful and deliberate intent to cause
4 confusion, mistake and deception among members of the relevant public and to
5 trade on the goodwill associated with the mark.

6 79. By reason of Defendants' acts, as alleged herein, Zox Company has
7 suffered damage to its business, reputation and goodwill and Defendants have
8 realized profits and sales they would not have made but for Defendants' conduct.

9 80. Defendants' acts have caused and will continue to cause irreparable
10 and immediate injury to Zox Company for which Zox Company has no adequate
11 remedy at law. Unless Defendants are restrained by this Court from continuing
12 their unauthorized use of words and symbols that are confusingly similar to the
13 ZOX Mark, these injuries will continue to occur.

14 **THIRD CLAIM FOR RELIEF**

15 (Against All Defendants for Common Law Trademark Infringement)

16 81. Zox Company repeats and re-alleges paragraphs 1-68, 70-74, and 76-
17 80, as though fully set forth in this paragraph.

18 82. By reason of Defendants' acts, as alleged herein, Zox Company has
19 suffered damage to its business, reputation and goodwill and Defendants have
20 realized profits and sales they would not have made but for Defendants' conduct.

21 83. The above-described acts of Defendants constitute common law
22 trademark and trade name infringement. Such acts have caused and will continue
23 to cause irreparable and immediate injury to Zox Company for which Zox
24 Company has no adequate remedy at law. Unless Defendants are restrained by this
25 Court from continuing the acts alleged herein, these injuries will continue to occur.

26 84. On information and belief, the foregoing acts of Defendants are
27 oppressive, fraudulent, willful and malicious in that they have been undertaken
28

1 with a conscious disregard of Zox Company's rights and with a desire to injure
2 Zox Company's business and to improve its own.

3 **FOURTH CLAIM FOR RELIEF**

4 (Against All Defendants for Unfair Competition,
5 Cal. Bus. & Prof. Code § 17200)

6 85. Zox Company repeats and re-alleges paragraphs 1- 68, 70-74, 76-80,
7 and 82-84, as though fully set forth in this paragraph.

8 86. The above-described acts of Defendants constitute unfair competition
9 within the meaning of California Business and Professions Code Section 17200.
10 Such acts have caused and will continue to cause irreparable and immediate injury
11 to Zox Company for which Zox Company has no adequate remedy at law. Unless
12 Defendants are restrained by this Court from continuing the acts alleged herein,
13 these injuries will continue to occur.

14 **FIFTTH CLAIM FOR RELIEF**

15 (Against All Defendants for Common Law Unfair Competition)

16 87. Zox Company repeats and re-alleges paragraphs 1- 68, 70-74, 76-80,
17 82-84 and 86, as though fully set forth in this paragraph.

18 88. By reason of Defendants' acts, as alleged herein, Zox Company has
19 suffered damage to its business, reputation and goodwill and the loss of profits and
20 sales it would have made but for Defendants' conduct.

21 89. The above-described acts of Defendants constitute common law unfair
22 competition in that Defendants are attempting to pass off its goods and services as
23 those of Zox Company. Such acts have caused and will continue to cause
24 irreparable and immediate injury to Zox Company for which Zox Company has no
25 adequate remedy at law. Unless Defendants are restrained by this Court from
26 continuing the acts alleged herein, these injuries will continue to occur.

27 90. On information and belief, the foregoing acts of Defendants are
28 oppressive, fraudulent, willful and malicious in that they have been undertaken

1 with a conscious disregard of Zox Company's rights and with a desire to injure
2 Zox Company's business and to improve its own.

3 **PRAYER FOR RELIEF**

4 WHEREFORE, Plaintiff prays for judgment against Defendants as follows:

5 1. For an order permanently enjoining the Defendants, their officers,
6 agents, employees, and those acting in concert or conspiracy with them from:

7 a. Using any brand or designation that makes use of the
8 term ZOX or any permutation of that term, whether alone or in combination with
9 other words, characters or symbols in connection with the sale, offer for sale,
10 promotion or advertising of any products and/or services that are the same as, or
11 are related to, Zox Company's goods and services;

12 b. Instructing or directing any third parties to prepare print
13 advertising, flyers, containers, labels or packaging bearing the term ZOX or any
14 permutation of that term, whether alone or in combination with other words,
15 characters or symbols for use in connection with the sale, offer for sale, promotion
16 or advertising of any products and/or services that are the same as, or are related to,
17 Zox Company's goods and services;

18 c. Imitating, copying, making unauthorized use of, or
19 otherwise infringing, Plaintiff's rights in and to the ZOX Mark;

20 2. For an order directing the Defendants to deliver up for destruction all
21 products, labels, boxes, signs, prints, packages, wrappers, and artwork in their
22 possession, or under their control, bearing or intended to bear the term ZOX or any
23 permutation of that term, whether alone or in combination with other words,
24 characters or symbols;

25 3. For an order pursuant to 15 U.S.C. § 1125(c)(1) permanently
26 enjoining Defendants and their officers, agents, employees, and all those acting in
27 concert or conspiracy with them from making use of the ZOX or any other term
28 that contains the term ZOX or any phonetic equivalent of that mark in connection

1 with the wholesale or retail sale of goods or services related to the Zox Company's
2 goods and services;

3 4. For an order cancelling U.S. Registration No. 5,268,843 in whole, or
4 in part;

5 5. For an order abandoning U.S. Application Serial No. 88/228,839;

6 6. For a monetary award against Defendants in favor of Zox Company in
7 an amount equal to (i) Zox Company's actual damages and (ii) to the extent not
8 included in actual damages, the Defendants' profits arising from the acts alleged
9 above, such damages and profits to be trebled under 15 U.S.C. § 1117(a);

10 7. For a finding that this is an exceptional case within the meaning of,
11 and for an award of attorneys' fees against Defendants pursuant to, 15 U.S.C. §
12 1117(a);

13 8. For a finding that Defendants' acts of infringement were willful
14 within the meaning of 15 U.S.C. § 1117(c)(2);

15 9. For an award of pre-judgment interest and post-judgment interest in
16 the maximum amount permitted by law;

17 10. For a finding that Defendants' acts were undertaken intentionally,
18 maliciously and/or with a reckless and wanton disregard of Plaintiff's rights and
19 for an award of exemplary damages pursuant to California Civil Code section 3295
20 in an amount sufficient to punish, deter, and make an example of Defendants for
21 the acts complained of herein;

22 11. For an award of costs under 15 U.S.C. § 1117(a), or as otherwise
23 provided by law against Defendants;

24 12. For exemplary and punitive damages against Defendants; and

25 ///

26 ///

27 ///

CISLO & THOMAS LLP

By: /s/Daniel M. Cislo

David B. Sandelands

Katherine M. Bond

Attorneys for Plaintiff ZOX LLC

REQUEST FOR JURY TRIAL

Plaintiff requests trial by jury on all issues so triable.

CISLO & THOMAS LLP

Dated: February 22, 2021

By: /s/Daniel M. Cislo

Daniel M. Cislo

David B. Sandelands

Katherine M. Bond

Attorneys for Plaintiff ZOX LLC